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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/878,177	06/18/97	IWAMOTO	M SDEI-5001

<input type="checkbox"/>	HM31/1026	<input type="checkbox"/>	EXAMINER
MORGAN LEWIS & BOCKIUS 1800 M STREET NW WASHINGTON DC 20036			WILSON, M
<input type="checkbox"/>		ART UNIT	PAPER NUMBER
		1633	

**DATE MAILED:** 10/26/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. <b>08/878,177</b>	Applicant(s) <b>Iwamoto et al.</b>
Examiner <b>Wilson, Michael C.</b>	Group Art Unit <b>1633</b>

Responsive to communication(s) filed on \_\_\_\_\_.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 1-19 is/are pending in the application.

Of the above, claim(s) none is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 1-19 are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

## **DETAILED ACTION**

Claims 1-19 are under consideration in the instant application.

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 and 5, drawn to protein, classified in class 530, subclass 350.
  - II. Claim 2, drawn to DNA, classified in class 536, subclass 23.1.
  - III. Claims 3-4, 15, 17 and 19, drawn to pharmaceutic compositions comprising a protein, classified in class 514, subclass 2.
  - IV. Claims 6-7, drawn to antibodies, classified in class 530, subclass 387.1.
  - V. Claims 8-9 and 12, drawn to a method of measuring gene expression using a probe against DNA, classified in class 435, subclass 6.
  - VI. Claims 8 and 10-13, drawn to a method of measuring gene expression using an antibody, classified in class 436, subclass 500.
  - VII. Claim 14, drawn to a method of screening compounds using transformed cells, classified in class 435, subclass 455.
  - VIII. Claims 16 and 18, drawn to a pharmaceutical composition comprising DNA, classified in class 514, subclass 44.
2. The inventions are distinct, each from the other because of the following reasons:  
Inventions of Groups 1-VIII are unrelated. Inventions are unrelated if it can be shown that they

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are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case, Group I is different than Groups II-VIII because the protein of Group I has a separate use which is as a dietary source of nutrition. Group II is different than Groups III-VIII because the DNA of Group II has different function which is to make protein. Group III is different than Groups IV-VIII because the pharmaceutical compositions comprising protein have a different function which is therapy and differ from Group VIII because they require separate and distinct protocols and reagents. Group IV is different than Groups V-VIII because the antibodies of Group IV have a separate use which is to isolate proteins. Group V is different than Groups VI-VIII because the method of measuring gene expression using a probe against DNA requires separate and distinct protocols and reagents than the method of Group VI and because it has a separate use than Groups VII and VIII which is measuring gene expression. Group VI is different than Groups VII and VIII because it has a separate use which is measuring gene expression. Group VII is different than Group VIII because the method of screening compounds using transformed cells of Group VII is of separate use than the pharmaceutical composition of Group VIII and requires separate and distinct protocols and reagents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Wilson whose telephone number is (703) 305-0120. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasemine C. Chambers, can be reached on (703) 308-2035. The fax phone number for this Group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-0196.

Michael C. Wilson  
October 21, 1998

*Deborah Crouch*

DEBORAH CROUCH  
PRIMARY EXAMINER  
GROUP 1800/630